

REMARKS

The Examiner is thanked for the thorough examination of this application. The present Office Action, however, has tentatively rejected all claims 1-9 and 11-14. In response, claims 1-2 and 14 have been amended to more clearly identify a novel and non-obvious aspect of the claimed embodiments. In view of the foregoing amendments and following remarks, it is requested that the rejections of the record be reconsidered and withdrawn, and that the application be found to be in allowable condition.

Discussion of 102 Rejections

Claims 1-4, 6, 8 and 12 were tentatively rejected under 35 USC 102(e) as allegedly anticipated by published application 20030011350 (to Gregorius). In view of the amended language of claim 1, Applicant respectfully requests that this rejection be withdrawn.

As recited in amended claim 1, the first reference voltage is provided by a voltage divider according to a power source and is independent to the output voltage. Namely, the first reference voltage is not generated or controlled by the output voltage V_{out} . This feature is specifically embodied in the amended language of claim 1, which recites: "a voltage divider to provide the first reference voltage according to an power source, wherein the first reference voltage is independent to the output voltage."

In contrast, Gregorius discloses a first reference voltage (the gate voltage of the MN1) that is controlled and generated by the operational amplifier OTA1, according to the output voltage V_{out} . Thus, the first reference voltage, asserted by the Office Action in Gregorius' patent ('350), is different from that defined in amended claim 1.

As Gregorius does not teach a first reference voltage independent to the output voltage as recited in the claim 1, Gregorius does not disclose all features of the claimed embodiment, and the rejection of claim 1 should be withdrawn. Insofar as claims 2-4, 6, 8 and 12 depend from claim 1, the 102 rejection of claims 1-4, 6, 8 and 12 has been distinguished and should be withdrawn.

Discussion of 103 Rejections

The Office Action tentatively rejected claim 5 under 35 USC 103 as allegedly unpatentable over Gregorius in view of Khalid (20040150464). In addition, the Office Action rejected claims 1-4, 6, 8, and 11-14 are rejected under 35 USC 103 as allegedly unpatentable over Chen et al (6433521) in view of Shyu et al (5,221,890). Further still, the Office Action tentatively rejected claim 5 under 35 USC 103 as allegedly unpatentable over Chen et al ('521) in view of Shyu et al ('890) and Khalid ('464). Finally, the Office Action rejected claim 7 under 35 USC 103 as allegedly unpatentable over Chen et al ('521) in view of Shyu et al ('890) and Shulman (6064258).

In order to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Turning first to the rejection of claim 5, based on the combination of Gregorius in view of Khalid, Applicant respectfully submits that this rejection should be withdrawn for at least the

same reason as claim 1 (set forth above). Namely, as recited in amended claim 1, the first reference voltage is provided by a voltage divider according to an power source and is independent to the output voltage. The first reference voltage is not generated or controlled by the output voltage V_{out} . In Gregorius' patent, however, the first reference voltage (the gate voltage of the MN1) is controlled and generated by the operational amplifier OTA1 according to the output voltage V_{out} . Thus, the first reference voltage, asserted by Office Action, in Gregorius' patent ('350) is different from that defined in amended claim 1.

Turning now to the rejection of claim 1-4, 6, 8, and 11-14, based on the combination of Chen and Shyu, Applicant again submits that the added claim limitation defines over the combined teachings of these two references. In this regard, the first reference voltage (the gate voltage of the transistor 14), asserted by Office Action, in Chen patent ('521) is controlled and generated by the amplifier 10 according to the output voltage V_o . Thus, the first reference voltage of Chen patent ('521) is different from that defined in amended claim 1 (i.e., "a voltage divider to provide the first reference voltage according to an power source, wherein the first reference voltage is independent to the output voltage"). For at least this reason, the rejection of claims 1-4, 6, 8, and 11-14 should be withdrawn. The further rejections of dependent claims 5 and 7 should be withdrawn for at least the same reason.

As a separate and independent basis for the traversal of these 103-based rejections, Applicant respectfully submits that the Office Action has failed to cite a proper motivation for combining the selective teachings of the various cited references. It is well-settled law that in

order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a voltage reference generator, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may

flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

In rejecting claim 1, based on the combination of Chen and Shyu, the Office Action has failed to comply with the legal standards set forth above. Specifically, in combining the two references, the Office Action states only that the combination would have been obvious "for the purpose of reducing noises." This alleged motivation is clearly improper in view of the well-established case law. Indeed, such a result-based motivation could be cited by the PTO to reject virtually any claim presented for patenting, and the Federal Circuit has developed legal standard to present such an inappropriate application of prior art. For at least this additional reason, Applicant traverses the rejections of claims 1, -4, 6, 8, and 11-14.

For at least the foregoing reasons, Applicant submits that all claims are in condition for allowance.

No fee is believed to be due in connection with this submission. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,


Daniel R. McClure; Reg. No. 38,962

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500